

REMARKS

I. Introduction

Claims 1 to 11, and 13 to 16 are currently pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, the Examiner indicates that claims 1 to 16 are pending in the present application. Applicants note that claim 12 was canceled without prejudice in the Amendment filed on March 31, 2005.

II. Rejection of Claims 1 to 11, and 13 to 16 Under 35 U.S.C. § 103(a)

Claims 1 to 11, and 13 to 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,779,196 ("Igbinadolor") and U.S. Patent No. 5,588,046 ("Knuth et al."). It is respectfully submitted that the present rejection should be withdrawn for at least the following reasons.

To establish a *prima facie* case of obviousness, the Office Action must demonstrate three criteria: (1) there must be some suggestion or motivation to one of ordinary skill in the art to modify a reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest each and every limitation in the claim under examination. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Final Office Action admits that Igbinadolor does not disclose an "input device [that] when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data," but instead refers to Knuth et al. as allegedly disclosing these features. The Final Office Action further states that it would have been obvious to modify the system of Igbinadolor to include the features discussed by Knuth et al. "because this will replay or recover the information which has been missed during malfunction." Knuth et al. provide for a telephone answering device that includes an audio random access memory chip, which is repeatedly checked to determine whether there is sufficient memory to record an outgoing message (OGM). If an OGM record key is pressed, the device enters from a RAM CHECK state to an OGM RECORD state, but if it is determined that there is not sufficient memory, the device returns to the RAM CHECK STATE without allowing for a recording of the OGM. Incorporating the features of exiting a recording state in response to a detection of insufficient memory does not provide for replaying or recovering "information which has been missed during malfunction." Therefore,

the Final Office Action is plainly deficient with respect to the requirement to provide a suggestion or motivation to make the proposed combination.

It is respectfully submitted that since there is no motivation or suggestion to make the proposed combination, the combination of Igbinadolor and Knuth et al. does not render unpatentable claim 1.

As for claims 2 to 11, and 13 to 16, which ultimately depend from claim 1 and therefore include all of the features recited in claim 1, it is respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable these dependent claims for at least the same reasons set forth above in support of the patentability of claim 1. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

In view of the foregoing, withdrawal of this rejection is respectfully requested.

III. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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